PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
024827-2701

I hereby certify that this correspondence is being deposited by EFS Web and is addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

On May 7, 2008

Signature:

Typed or printed name: Jessica A. Harvey

Application Number	Filed
10/600,295	6/20/2003
First Named Inventor	
John Wu	
Art Unit	Examiner
2616	Anh Vu H Ly

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 51,182

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

Signature

Sanjeev K. Dhand
Typed or Printed Name

(858) 847-6860
Telephone Number

May 7, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	John Wu
Title:	SYSTEMS AND METHODS FOR REGISTERING A CLIENT DEVICE IN A DATA COMMUNICATION SYSTEM
Appl. No.:	10/600,295
Filing Date:	6/20/2003
Examiner:	Anh Vu H Ly
Art Unit:	2616
Confirmation Number:	6301

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Claims 1-10, 13-40 and 42-50 remain pending in this application.

Claims 1-10, 14-24, 39-40 and 42-47 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Application Publication No. 2002/0089968 to Johansson *et al.* (hereinafter "Johansson") in view of U.S. Application Publication No. 2003/0108172 to Petty *et al.* (hereinafter "Petty"). Claims 13 and 25-38 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johansson in view of U.S. Application Publication No. 2005/0050148 to Mohammadioun *et al.* (hereinafter

"Mohammadioun"). Claims 48-50 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johansson and Petty in view of U.S. Patent No. 6,866,587 to Lane *et al.* (hereinafter "Lane"). Applicant respectfully traverses the rejection of the claims for at least the following reasons.

As noted in earlier papers by Applicant, embodiments of the present application relate to obtaining, tracking and maintaining a packet switched network address of client devices that are capable of packet switched communication with the network. In accordance with embodiments of the present invention, a client device is configured to send a packet switched network address when a packet switched data network assigns the client device a new packet switched network address. Accordingly, notification and configuration protocols are provided wherein the client device may move from one zone to another, is in need of a DHCP renewal or is shutting down, requiring re-registration of a new packet data network address to be assigned. See Specification, Paragraphs [0043]-[0044]. Accordingly, independent claim 1 recites "a client device configured to send a new packet switched registration message whenever the packet switched data network assigns the client device a new packet switched network address."

In response to Applicant's arguments in the pending Final Office Action, the examiner cites Johansson as disclosing the occurrence of data transmission after a connection is established at Page 4, paragraph [0045]. Applicant respectfully disagrees with this interpretation of the disclosure of Johansson.

Johansson describes two different systems for communicating between a server and a wireless communication station. Specifically, one system, as shown in Fig. 2 of Johansson, relates to the communication when there is no existing packet data session between the wireless communication station and the server (Johansson, page 5, paragraph [0047]). The other system, as shown in Fig. 1 of Johansson, relates to the communication when a data session has already been established between the wireless communication station and the server (Johansson, page 4, paragraph [0035]). Johansson discloses a method for establishing a connection between the server and the wireless communication station by first using the system described in Fig. 2. Once such initial communication is established, further communication is conducted according to the system described in Johansson's Fig. 1. The

latter communication involves the exchange of the wireless communication station's "static and dynamic radio capabilities" (Johansson, page 4, paragraphs [0038] – [0040]). Static capabilities include radio access classmark of the GPRS station, and its multi-slot capability (Johansson, page 4, paragraph [0039]). Dynamic capabilities include the quality of service (QOS) that can be provided by the GSM/GPRS network (Johansson, page 4, paragraph [0040]).

The portions of Johansson relied upon by the examiner in rejecting claim 1 (Johansson, page 5, paragraph [0047] to page 6, paragraph [0059] and Fig. 2) relate only to establishing a connection before the existence of a packet data session between the wireless communication station and the server, and not to activities occurring after a connection is established.

The Examiner has further indicated that claim 1 of the present invention does not recite activities occurring after a connection is established. Applicant respectfully disagrees. Specifically, the last element of claim 1 recites: "the client device is further configured to include a packet switched network address with a packet switched registration message sent to the central authority and to send a new packet switched registration message whenever the packet switched data network assigns the client device a new packet switched network address." As evident from the claim language, the initial communication between the central authority device and data network is established when the packet switched registration message is sent to the central authority, and that the sending of a new packet switched registration massage occurs subsequently, whenever there is a new packet switched network address. As such, Johansson fails to teach or suggest at least this element of the present invention as recited in claim 1.

Furthermore, Petty fails to cure the deficiencies of Johansson. Petty describes an Internet call waiting (ICW) service that allows callers to screen voice messages in real-time to either terminate or re-route the call. The section of Petty relied upon by the Examiner (Petty, page 4, paragraph [0038]) describes that the ICW software application re-registers with the ICW registration server at regular intervals. The re-registration time interval may be set, for example, to occur at intervals of 10-20 minutes. If the ICW client computer loses Internet connectivity during an ICW session, as soon as the Internet connection has been established,

the ICW registration server is updated with the new IP address of the ICW client computer. Thus, Petty discloses re-registering the client e.g., every 10-20 minutes. The section of Petty cited by the Examiner fails to teach or suggest the last element of claim 1 of the present invention, namely that "the client device is further configured to include a packet switched network address with a packet switched registration message sent to the central authority and to send a new packet switched registration message whenever the packet switched data network assigns the client device a new packet switched network address."

In the Advisory Action dated April 8, 2008, the Examiner argues that, in accordance with the disclosure of Petty "the client computer registers its new IP address with the registration server only after receiving a new IP address." Applicant respectfully disagrees. The re-registration disclosed in Petty is unrelated to the receiving of a new IP address. In accordance with the disclosure of Petty, the re-registration occurs at regular intervals. "The ICW client software application preferably re-registers with the ICW registration server at regular intervals." Petty, Page 4, paragraph [0038]. Thus, re-registration occurs whether or not a new IP address is assigned.

Thus, Johansson and Petty, either alone or taken together, fail to teach or suggest at least the above noted features of claim 1. Independent claim 39 recites a similar feature, and thus is patentable for the same reasons set forth above in connection with claim 1.

As to dependent claims 2-10, 14-24, 40-41 and 42-50 of the present invention, they depend, directly or indirectly, from allowable claims 1 and 39, and are therefore patentable for at least that reason, as well as for additional patentable features when these claims are considered as a whole.

The Examiner has also rejected independent claims 13 and 25 over Johansson in view Mohammadioun. The Examiner has indicated that "Mohammadioun discloses the server determines again if it has the capability to reestablish a link to the client on the remote device currently being registered by sending another message ([Mohammadioun,] Fig. 4, step 135) after the first message ([Mohammadioun,] Fig. 4, step 129). Herein, the remote device is not communicating with the server for a predetermined time." (Office Action, page 11, second paragraph). Applicant respectfully disagrees with the Examiner's interpretation of Mohammadioun as it relates to claims 13 and 25 of the present invention. Mohammadioun's

disclosure is directed towards a system and method for providing notification on remote devices. The sections of Mohammadioun relied upon by the Examiner (Mohammadioun, Fig. 4 and page 7, paragraphs [0071] and [0073]) describe the operation of an event notice registration agent, which runs on a sever, whose main responsibility is to collect registration events from the server and maintain the list of remote device clients that are available to receive notifications. The event notice registration agent of Fig. 4, after initiating contact with a client, determines if the server has the capability to establish a link to the client (step 129). Then, regardless of whether such capacity exists, if there are any outstanding event notice messages for that particular client, the event notice registration agent determines if the server has the capacity to establish a link in order to send out outstanding event notice messages to the client (step 135). Thus Mohammadioun's event notice registration agent (which, itself, is running on the server) communicates with the server twice - once in step 129 and once in step 135 - in order to assess whether the server has the capability to establish a link to the client. As such, the cited sections of Mohammadioun fail to teach or suggest the central authority further configured to send a new circuit switch message to the client device if the client device has not communicated with the central authority for a predetermined time, as is recited in claims 13 and 25 of the present invention.

Accordingly, claims 13 and 25 are patentable for at least that reason. As to dependent claims 24-38 of the present invention, they depend directly, or indirectly, from allowable claim 25, and are therefore patentable for at least that reason, as well as for additional patentable features when these claims are considered as a whole.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date May 7, 2008 By /Sanjeev K. Dhand/

FOLEY & LARDNER LLP
Customer Number: 30542
Telephone: (858) 847-6860
Facsimile: (858) 792-6773

Sanjeev K. Dhand
Attorney for Applicant
Registration No. 51,182